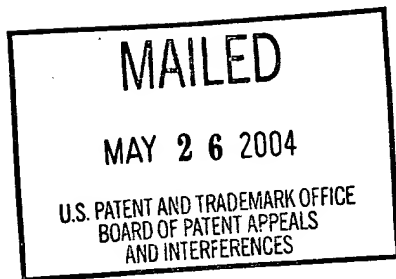


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**



Ex parte RONNI S. STERNS et al.

Appeal No. 2004-1127
Application No. 09/663,329

ON BRIEF

Before COHEN, FRANKFORT, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

REMAND

We remand this application to the examiner for action as may be appropriate. Specifically, we remand this application to the examiner to (1) further consider the rejections of independent claims 1 and 19 under 35 U.S.C. § 103; and (2) consider if independent claim 10 is anticipated under 35 U.S.C. § 102(b).

Issue 1

Independent claim 1 stands rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 3,081,560 to Campo Agud in view of U.S. Patent No. 6,024,571 to Renegar and U.S. Patent No. 4,478,582 to Tucker. Independent claim 19 stands rejected under 35 U.S.C. § 103 as being unpatentable over Campo Agud in view of Renegar and Tucker and further in view of four additional patents. See pages 2-3 and 7-10 of the final rejection (Paper No. 8, mailed September 23, 2002). In both of these rejections, the examiner concluded that it would have been obvious to one of ordinary skill in the art to modify Campo Agud by (1) providing a phonetic transliteration of the target phrase on each card as suggested by Renegar; and (2) further providing an appropriate background color to each card for the user to categorize the cards as suggested by Tucker.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references **to arrive at the claimed invention**. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Based on our analysis and review of Campo Agud and claims 1 and 19, it is our opinion that the differences include (1) "the display card having a background color that corresponds to a particular subject or category"; (2) the source phrase displayed on the display card in the first language being "located predominantly in a upper, central portion of the display board^[1] and being associated with the background color"; (3) the target phrase displayed on the display card constituting a translation of the source phrase in the second language being "located to one side of the source phrase"; (4) the display card having "a phonetic transliteration of the target phrase in the first language"; and (5) the phonetic transliteration being "located beneath the source phrase."

In the rejection of claims 1 and 19 under 35 U.S.C. § 103 the examiner has only addressed differences (1), (2) and (4). Since the examiner has not addressed differences (3) and (5), the examiner has not established that it would have been obvious at the time the invention was made to a person of ordinary skill in the art to combine the relevant teachings of the references **to arrive at the claimed invention**.

Accordingly, we remand this application to the examiner to further consider the patentability of claims 1 and 19 in light of differences (3) and (5).

¹ It appears to us that "display board" in this limitation should be -- display card --. The appellants and the examiner should take the necessary steps to see if claims 1 and 19 should be so amended.

Issue 2

Independent claim 10 stands rejected under 35 U.S.C. § 103 as being unpatentable over Campo Agud in view of U.S. Patent No. 6,139, 331 to Owen and U.S. Patent No. 3,154,870 to Hopp. See pages 4-6 of the final rejection.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it."

It appears to us that claim 10 might be readable on Hopp. Specifically, Hopp appears to disclose a sign assembly capable of being used as part of a phonetic transliteration card display in which display cards can be observed by users, the sign assembly including a plurality of identical lettering panels 19 (i.e., display boards) which

can be joined together by their respective extensions 43 and grooves 42 (i.e., first and second connectors). Each lettering panel has (1) a wall 39 on which cards 20 can be secured removably to both the front and back; (2) thickened generally parallel portions 37 and 38 (i.e., top and bottom walls) connected to and extending rearwardly from the wall 39; and (3) retaining lips 40 generally parallel with the front wall (i.e., upper and lower rear flanges) connected to and extending from both the front and rear of the respective thickened portions 37 and 38. The wall 39, the respective thickened portions 37 and 38 and the front retaining lips 40 define a first chamber within which cards can be stored. The wall 39, the respective thickened portions 37 and 38 and the rear retaining lips 40 define a second chamber within which additional cards can be stored. Each lettering panel also includes extensions 43 (i.e., the first connector) as part of the thickened portion 37 and a groove 42 (i.e., the second connector) as part of the thickened portion 38, the extensions 43 being configured to engage with a mating groove 42 included as part of the thickened portion 38 of another lettering panel, and the groove 42 being configured to engage with mating extensions 43 included as part of the thickened portion 37 of another lettering panel.

Accordingly, we remand this application to the examiner to consider if independent claim 10 is anticipated by Hopp under 35 U.S.C. § 102(b).

CONCLUSION

We hereby remand this application to the examiner for action as required by this remand, and for such further action as may be appropriate. However, this remand is not for the purpose of a supplemental examiner's answer. Accordingly, a supplemental examiner's answer is not permitted.

This application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01. It is important that the Board of Patent Appeals and Interferences be promptly informed of any action affecting the appeal in this application.

REMANDED

BOARD OF PATENT
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AND
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